



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

86769-0063

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

09/693,437

Filed

October 20, 2000

First Named Inventor

Kerry MOK

Art Unit

3621

Examiner

Firmin Backer

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 47,818

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

David D. Nelson

Typed or printed name

(202) 637-6807

Telephone number

March 27, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 09/693,437 Confirmation No.: 8707
Applicant(s) : Kerry MOK *et al.*
Filed : October 20, 2000
TC/A.U. : 3621
Examiner : Firmin Backer
Title : METHOD AND SYSTEM FOR FACILITATING A
: TRUSTED ON-LINE TRANSACTION BETWEEN
: BUSINESSES AND NETWORKED CONSUMERS

Docket No. : 86769-0063
Customer No. : 30398

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

SUPPLEMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants hereby submit this document in support of the attached Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal Filed in accordance with 37 C.F.R §41.31, along with a request for a two (month) extension of time following receipt of a Final Office Action (the "Final Action") dated October 25, 2005.

Current Status of the Present Application

Currently, claims 1-62 remain in the present application. The Final Action rejects claims 1-62 under 35 USC §103(a) as being unpatentable over by U.S. Published Application No. 20010049634 (the "Stewart" reference) in view of U.S. Patent No. 5,903,873 (the "Peterson" reference). [Final Action at pages 2-9]. Applicants submitted an Amendment dated January 25, 2006 (the "Amendment"), and subsequently received an Advisory Action dated February 23, 2005 continuing the rejection claims of 1-62 under 35 USC §103(a), noting that the Applicants' arguments were not persuasive and failed to place the application in condition for allowance. Applicants respectfully disagree with this finding as being both legally incorrect and factually without merit.

Arguments

Applicants suggest:

A) There is no motivation to combine Stewart and Peterson under 35 USC §103(a) except to wrongly recreate in hindsight the present invention as embodied in claims 1-62.

B) Stewart is non-enabling, and thus cannot be prior art under 35 USC §102/103

B) Even if Stewart and Peterson could rightfully be combined, the combination of Stewart and Peterson fails to teach the each and every limitation of the present invention as embodied in claims 1-62.

A. There is No Motivation to Combine Stewart and Peterson

In the Final Action at page 3 starting at page 15, it is argued that it would be obvious to combine Stewart and Peterson merely since both references are generally related to “facilitating transactions.” Applicants respectfully disagree with this finding.

According to its abstract, Stewart generally relates to “An on-line interactive network community for the integrated purchase and sale of metals, particularly steel.” As further discussed in its abstract, Stewart related to a private business-to-business network for selling steel. Stewart specifically teaches that the various disparate businesses are registered (for example at Paragraph 25) and that the registered businesses exchange proprietary business operation information (for example at Paragraphs 27-28), and confidential financial information (for example at Paragraphs 28-29). Essentially, Stewart represents a supply chain tool particularly adapted to the steel market. Stewart addresses the problem of facilitating a transaction between different partners.

In contrast, Peterson discloses a method to allow remotely located individual insurance agents to register and communicate insurance transactions to an insurance company’s central office in batch mode. These agents are employees or otherwise affiliated with the insurance company, and thus, are not customers or trading partners. Peterson addresses the problem of securely collecting and transferring confidential client information within a single business.

It is readily apparent that while Stewart and Peterson generally relate to the use of computer networks in commerce, the two reference related to different industries and to different

technical and business problems. Therefore, Applicants urge that no motivation to combine the two references appears within the four corners of the references, and that the references, in fact, teach away from one another.

B) Stewart is non-enabling, and thus cannot be prior art under 35 USC §102/103

Applicants cannot understand and properly response to Stewart as it appears to be incomplete. Specifically, the specification of Stewart references FIGS 1-5, and only FIG. 1 appears in the published applications. Consequently, Applicants are confused as to the particular methodology and systems performed in Stewart, and cannot specifically respond except to discuss vague generalities. While it appears on the public PAIR system that the supplemental figures were submitted in Stewart, these figures are not available to the public.

C. The Combination Of Stewart And Peterson Does Not Teach The Each And Every Claim Limitation

Applicants urge that the combination of Stewart, as best understood, and Peterson does not teach the each and every claim limitation, as argued at pages 15-17 of the Amendment. For purposes of discussion, current Claim 1 is reproduced below, with reference numbers added for clarity:

A method facilitated by a computer network to accomplish a trusted insurance transaction between an insurance business entity and a plurality of individual networked insurance consumers forming a network entity, comprising the acts of:

(i) providing an administrative server having a communications channel for electronically communicating with the insurance business entity and having a communications channel for electronically communicating with the networked entity and the networked insurance consumers;

(ii) providing an insurance business registration system in the administrative server wherein the insurance business entity can be authenticated and a unique identifier is assigned to the insurance business entity (BEID), whereby the insurance business entity is designated a registered insurance business entity;

(iii) allowing the registered insurance business entity to selectively access the administrative server to submit details of insurance products and/or services provided by the registered insurance business entity and to view selections made by the networked insurance consumers associated with said BEID

wherein the administrative server will store the details of products and/or services provided by the registered insurance business entity;

(iv) providing a networked entity registration system in the administrative server wherein the networked entity can be authenticated, whereby the networked entity is designated a registered networked entity; and

(v) providing a networked insurance consumer registration system in the administrative server whereby each of said networked insurance consumers who has authorized access to a registered networked entity's system can be designated a registered insurance consumer and assigned a unique registered insurance consumer identifier (RCID),

(vi) and whereby each of said registered insurance consumers can access data provided by the registered insurance business entity and associated with said RCID and can make personal selections on the data, the selections being stored in the administrative server.

Thus, the present invention as embodied in claim 1, provides a method where: (i) there is an administrative server, (ii) the insurance business entity (i.e., an insurance carrier) registers with the administrative server, the (iii) the insurance company can access the administrative server to provide product information and to receive stored insurance orders from the customers, and (vi) allowing registered customers access to the insurance product information to view the product information and to select insurance products. Applicants believe that claim elements i. – iii. and vi. likely found in Stewart that generally provides for the registration of commercial partners and the exchange of information between the commercial partners to enable commercials transactions.

Applicants urge however that elements (iv) the separate registration of a network entity (i.e., the employer) formed by a plurality of the customers (i.e., the employees) and (v) registration of the customers authorized to use the registered network entity's system are not found in Stewart, and that Peterson does not make up for this deficiency. The Final Action, for example, at page 3, discusses the registered customers and network entities as being one in the same, and Stewart, for example at Paragraph 20, discloses a buyer that is synonymous with the corporate entity that buyer represents. Likewise, at page 9, in response to Applicants' previous arguments, the Final Action appears to argue that (1) there is confusion between the concepts of registered customers and network entities, and that the two are one in the same, even though Applicants have clearly defined two distinctly in the claims and specification. The Final Action further argued at page 10 that Peterson provides a system where a plurality of uniquely identified

Application No. 09/693,437
Supplement To Pre-Appeal Brief Request For Review
In Reply to Office Action mailed October 25, 2005

insurance agents can forward information to a central company, but Applicants urge that Peterson does not provide for a network entity formed by a plurality of customers in that the agents are not "customers" and that the insurance company cannot be both the "insurance business entity" and the "network entity" formed by the plurality of customers as specified in claim 1.

In paragraph 4, the Final Action appears to argue that the separate customers are inherent in a business (e.g., multiple buyers from the same company) but there is no suggestion in Stewart of separately registering different employees from the same company. Instead, Stewart, as best understood, uniquely identifies each company, as stated above.


Therefore, for these and other reasons, Applicants urge that claim 1 is allowable over the combination of Stewart and Peterson. The other independent claims 16, 31, 46, and 52 also contain the "network entities" and should be similarly allowable. Remaining claims should be 2-15, 17-30, 32-45, 47-51, and 53-62 should be allowable as depending from allowable claims. Alternatively, dependent claims 2-3, 11, 17-18, 26, 32-33, 41, and 50 are separately patentable in that neither Stewart nor Peterson (since neither provides a network entity system) discloses customers/business entities access the network entity system.

EXCEPT for fees payable under 37 CFR §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 CFR §1.16 and 1.17 which may be required, including any required extension of time fees, or credit, any overpayment to deposit account No. 50-1349. This paragraph is intended to be a constructive petition for extension of time in accordance with 37 CFR §1.136(a)(3). If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1349.

Respectfully submitted,

Dated: March 27, 2006

HOGAN & HARTSON LLP
555 13th Street, N.W.
Washington, D.C. 20004
Telephone: 202-637-5600
Facsimile: 202-637-5910
Customer No. 30398

By: 
Celine Jimenez Crowson
Registration No. 40,357

David D. Nelson
Registration No. 47,818